

## R E M A R K S

In the present Application, no claim amendments have been made. As such, Claims 42-71 are pending. The Examiner's rejections are as follows:

- I. Claims 42, 44-47, 49-52, 54-57, 59-62, 64-67, and 69-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Aruffo ('693 patent).
- II. Claims 42-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aruffo et al, and further in view of Hagiware et al.
- III. Claims 42-71 stand rejected under 35 U.S.C. 102(f) in light of the Watkins 1.131 Declaration.

### **I. Aruffo et al. Rejection Under 102(e)**

The Examiner rejected Claims 42, 44-47, 49-52, 54-57, 59-62, 64-67, and 69-71 under 35 U.S.C. 102(e) as being anticipated by Aruffo et al. (U.S. Pat. 6,312,693). The Examiner indicated that the 1.131 Declaration of Dr. Watkins was not deemed persuasive in removing this rejection (Office Action page 2-3). While Applicants disagree with the Examiner's position and believe the 1.131 Declaration (filed in accordance with MPEP 715) is sufficient to remove Aruffo et al. as a reference, Applicants have concluded that a CFR 1.132 Declaration may be more appropriate in this situation to expedite prosecution.

The appropriate 1.132 Declaration has previously been filed in this Application addressing the Aruffo patent. On April 30, 2002, Applicants filed a 1.132 Declaration by Dr. Watkins in conjunction with a Supplemental Information Disclosure Statement that listed the Aruffo patent. This 1.132 Declaration supplied the necessary "unequivocal statements" as required under MPEP 716.10 to prevent the Aruffo patent from being cited as a 102(e) prior art reference.

It is noted that the Examiner, after being made aware of the Aruffo patent in the Supplemental IDS, did not cite the Aruffo patent in two subsequent Office Actions. However,

over a year later, in the Office Action dated April 29, 2003, the Examiner did cite the Aruffo patent as 102(e) art, apparently unaware that the 1.132 Declaration had been filed with the Supplemental IDS.

In light of this course of events, Applicants have attached a courtesy copy of this 1.132 Declaration at Tab A to the present communication. Applicants submit that this Declaration provides the proper unequivocal statements in accordance with MPEP 716.10 to remove the Aruffo reference as a citable 102(e) reference (i.e. this Declaration carefully tracks the requirements of MPEP 716.10 and is more than sufficient to remove the Aruffo reference). In light of this 1.132 Declaration, the 102(e) rejection under Aruffo must be withdrawn.

## **II. Aruffo et al. and Hagiwara Obviousness Rejection**

The Examiner has rejected Claims 42-71 under 35 U.S.C. 103(a) as being unpatentable over the Aruffo et al. patent and Hagiware et al patent. (Office Action page 3). In light of the attached 1.132 Declaration, it is clear that the Aruffo et al. patent cannot be cited by the Examiner. As such, Applicants respectfully submit that this rejection is moot.

## **III. 35 U.S.C. 102(f) Rejection**

The Examiner has rejected Claims 42-71 under 35 U.S.C. 102(f) alleging that the Applicants did not invent the claimed subject matter. In particular, the Examiner states that:

"Because of the declaration filed 7/31/03 by Dr. Watkins stating that **he performed the work** of the overlapping oligonucleotides and cites evidence in the comparison between various pages in the application and the patent of Arruffo, it is now unclear due to the statement in the declaration that Dr. Watkins **invented the oligo work** what the contributions of the other two inventors, Dr. Huse and Dr. Wu were." (*emphasis added*, Office Action, page 4).

Applicants submit that a careful reading of the 1.131 Declaration, and applying correct inventorship law, moots this rejection.

The Examiner appears to assert that Dr. Watkins was the only person to perform the cited work. Applicants note that the 1.131 Declaration actually says "[t]he overlapping oligonucleotide work described in pages 54-55 of the present specification was performed by me or was done under my supervision .." (Watkins 1.131 Declaration page 2, lines 1-2). As such, it is clear that Dr. Watkins never asserted he alone performed all of the work as alleged by the

Examiner.

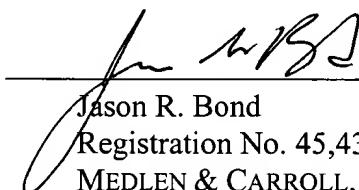
Second, the Examiner indicates that the Watkins 1.131 Declaration asserts that Dr. Watkins "invented" the oligo work. No such statement is present in the Declaration (again, see page 2, lines 1-2). In fact, the 1.131 Declaration does NOT discuss inventorship. Applicants remind the Examiner that inventorship relates to who *conceived* of the invention, not who actually reduced it to practice. The 1.131 Declaration does not comment on who invented the oligo work.

In light of the Examiner's mis-reading of the 1.131 Declaration, it is clear that there is no 102(f) issue as alleged by the Examiner. Moreover, it is noted that the re-submitted 1.132 Declaration DOES address inventorship, making affirmative statements that Dr. Watkins, Dr. Huse and Dr. Wu were the sole inventors of the oligo work (and not the other inventors listed on the front page of the Aruffo patent). As such, it is clear that this 102(f) rejection should be withdrawn immediately.

### CONCLUSION

For the reasons set forth above, it is respectfully submitted that Applicants' claims should be passed to allowance. If the Examiner believes an interview would help expedite the allowance of this case, Applicants ask the Examiner to please call the undersigned at 608-218-6900.

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